

## REMARKS

Claims 1-4 and 23 are pending in this application. None of the claims were amended in this response. Favorable reconsideration is respectfully requested.

Claims 1-4 and 23 stand rejected under 35 U.S.C. §103(a) as being anticipated by *Bush et al.* (U.S. Patent No. 5,475,585) in view of “ALANTEC: ALANTEC delivers another industry first; IP Multicast Routing Support for Desktop Video Conferencing and Broadcast Video” (Hereinafter “*Alantec*”). The Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not disclose at least “means for communicating a digital advertisement . . . using Internet transfer protocols” and “means for requesting, displaying and responding to digital advertising [presented using Internet transfer protocols]” as recited in claim 1 and similarly recited in claims 4 and 23. Applicant incorporates herein all of the substantive arguments submitted in the Response filed March 6, 2006. Applicant provides additional argumentation addressing the comments contained in the Final Office Action below.

Regarding the means-plus-function claims, Applicant again submits that the Office Actions, to date, have not explained how the structure of *Bush* is the same or equivalent to the structure recited in the present Application, with or without the amendments put forth in the previous response. The network sales system of the present application (FIG. 1, 200) is disclosed as a plurality of buyer computers (61, 62), merchant computers (63, 64), and a payment computer (68) interconnected over a network 67, where each merchant computer has a respective digital advertisement database (65) (page 10, lines 14-22). The network sales system utilizes an underlying software architecture, disclosed on page 11, lines 7-19 that comprises HTML, HTTP and URL's as mechanisms for transmitting documents within the network.

When communicating digital advertisements (FIGs. 3 and 6), an initial user inquiry 19 from the buyer computer results in an HTTP request 20 for a specific document with a specified URL, which also identifies the merchant computer. The merchant computer retrieves a document according to the URL and returns it to the buyer computer (page 13, lines 13-23). Under an alternate embodiment, the document is executed as a program originating from the merchant computer (page 13, lines 24 - page 14, line 8).

In contrast, *Bush* discloses a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals, and further incorporates credit-card swipers and special keypads for user input (col. 3, lines 21-30; col. 5, lines 34-44, line 65 to col. 6, line 9; col. 7, lines 22-35). *Bush* teaches a high capacity data input device 202, that loads vendor-specific menus via external disk storage devices 214 and 216, where the information is transferred to the main CPU 204, which controls the overall data formatting, and transmits the formatted data to parallel data to video interface 212 (col. 4, lines 54-66). Stored advertisement are transmitted asynchronously from corresponding databases to computer dedicated processor 201, where the processor 201 performs packet formatting and output this data in a synchronous manner that is polled by the main CPU 204. The main CPU 204, performs time multiplexing to gather data belonging to various vendors and service providers, assemble the data, and transmit it over the parallel bus to video interface 212. The video interface 212, converts the digital data into video format for transmission to receivers 26 (col. 5, lines 10-19).

The Office Actions have failed to explain how the use of a video interface converter is a “structure” that is the same or equivalent to the structure described in the specification which corresponds to the claimed means plus function (MPEP 2182). To be sure, the absence of a video interface under the teaching of *Bush* renders the entire system inoperable. Furthermore, the use of a video interface in the present application is wholly irrelevant. Moreover, Applicant respectfully submits the assertion that “*Bush* transmits video (including related advertisements) over a packet-switched network” is not correct (see Office Action page 7, 4<sup>th</sup> paragraph). As emphasized in the above paragraph, the video files are received for storage/buffering either through an asynchronous transfer from a vendor (201), or through a direct transfer from disk (202). When the video data is being prepared for transmission, the main CPU 204 polls the database and performs time multiplexing to load the data, and then forwards the transmission to the video interface that “[c]onverts the digital data into video format for transmission to receivers” (col. 5, lines 16-19).

Even if it is assumed that the loading of video data from the memory to the main CPU is “transmitting video,” it is not being done over a packet switched network, in which packets are routed between nodes over data links shared with other traffic. *Bush* explicitly discloses that the dedicated processor 201 packetizes asynchronous transmissions and forwards them in a

synchronous manner to CPU 204, which obtains this data via time multiplexing - no packet routing whatsoever is conducted in the disclosure of *Bush*. If anything, *Bush* discloses a RAID-type configuration (via SCSI/ESDI - see col. 5, lines 3-5, 20-23) for obtaining video data, which is an entirely different structure from that disclosed in the present application. Simply because *Bush* discloses “a processor, storage device and network” does not give the Patent Office license to pick and choose elements from the prior art, irrespective of their function, and ignore other elements essential to their operation (e.g., video converter, time multiplexing).

Additionally, *Bush* discloses a transmission being made by a transmitting source using a video signal that includes characters generated from a video character generator 206 (col. 1, lines 56-67; col. 3, lines 1-7; col. 5, lines 50-59; col. 6, lines 25-34). This also has not been explained in the Office Actions how the structural requirement for such a device correlates to the present claims.

Also, the “means for requesting, displaying and responding to digital advertising” are supported in the specification, for example, on pages 11-13, and discloses buyer computers receiving and linking HTML forms or documents received from merchants over a packet-switched network. In contrast, *Bush* discloses a structure utilizing multiple PLL synthesized tuners (215-16), channel control demodulators (217), demodulator data separators (214) and RF switches (213) to request, display and respond to video advertisements (col. 5, line 45-col. 6, line 9; col. 7, lines 6-21). Again, the Office has ignored these elements in formulating the rejection and continues to be silent in explaining how this structure is the same or equivalent to the configuration disclosed in the present application.

Regarding claim 2, Applicant rebuts the assertion that resolving missing payment information is well-known when the assertion is considered in light of the whole claim. *Bush* discloses that payment is submitted via a universal asynchronous receiver/transmitter device (UART) which converts bytes of to and from serial bit streams and represents them as electrical impulses (col. 6, line 58 - col. 7, line 5; col. 7, lines 26-35). There is imply no way that the UART device as disclosed in *Bush* can communicate missing payment information and allow the user to supply additional information (see col. 6, lines 35-57). The UART device, at best, can merely indicate whether a transaction was approved or not, since it involves the use of a standard credit/debit card arrangement (col. 3, lines 21-59). Considering that the UART device is

inherently incapable of communicating/receiving missing information, Applicant is at a loss understanding how one skilled in the art would “adapt *Bush*’s electronic credit card authorization means to incorporate means for communicating a missing payment information request message to said buyer computer” (page 9 of office action, 1<sup>st</sup> paragraph). To make this kind of adaptation, the vendors in *Bush* would have to be integrated with the transaction processor (30), and essentially be responsible for tracking each transaction and broadcasting authorization or request messages to each individual user. Such a configuration is neither taught nor suggested in the disclosure of *Bush*.

The Office Action goes further and submits that *Bush* does not “expressly teach that the digital advertisements are communicated to a buyer over the network using Internet transfer protocols.” In this regard, the Office Action relies on *Alantec* in solving these deficiencies. Applicant respectfully submits this combination is wholly improper.

There is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Bush* and *Alantec* references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). “A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant.” *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

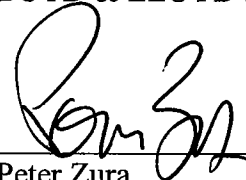
Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In the present case, *Alantec* discloses an IP multicast routing system where PC’s networked within a LAN can submit A/V messages to a central server (PowerHub), which in turn forwards the traffic to a selected group of users “who can simultaneously participate in video conferences, and other interactive desktop applications” (paragraph 6). This clearly has no application to *Bush*, and expressly teaches away from the disclosure. *Bush* (1) does not disclose any type of LAN architecture, (2) does not disclose the use of personal computers, (3) clearly does not allow viewers to send video advertisements *to each other*, (4) expressly relies on standard video transmission for broadcast and does not contemplate IP multicasting, (5) does not rely on servers for transmitting advertisements among users over a network, and (6) makes no provision whatsoever for IP communication anywhere in the system. In short, the IP multicast of *Alantec* runs counter to most every feature disclosed in *Bush*. It is inconceivable that the IP multicasting of *Alantec* could be incorporated into the system of *Bush* without essentially gutting and replacing most of the essential features contained within the reference.

For at least these reasons, the Applicants submit that the rejections under 35 U.S.C. §103 are improper and should be withdrawn. An early Notice of Allowance is earnestly requested. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (115274-00015) on the account statement.

Respectfully submitted,  
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